



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,624	12/29/2003	Shu-Chuan Chen	LA-7196-137.US	9898

167 7590 02/02/2007  
FULBRIGHT AND JAWORSKI LLP  
555 S. FLOWER STREET, 41ST FLOOR  
LOS ANGELES, CA 90071

EXAMINER
----------

BODDEN, EVRAL E

ART UNIT	PAPER NUMBER
----------	--------------

2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/02/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/750,624

Applicant(s)

CHEN ET AL.

Examiner

Evral Bodden

Art Unit

2109

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. This action is in response to the following communication: Non-provisional application filed 12/29/2003.
2. Claims 1-6 are pending. Claims 1 and 4 are independent claims. Claims 1-3 are method claims.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claim 4-6** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, and are limited to software and not to one of a process, machine, manufacture or composition of matter, and therefore fails to fall into a category of patent eligible subject matter.

Furthermore, **claims 4-6** fall under a Judicial Exception since they represent "abstract ideas", which attempts to produce a "practical application." To provide a "practical application", of a judicial exception, a "physical transformation" must occur, or the invention must produce a "useful, concrete, and tangible result."

**Claims 4-6** lacks "credibility" and is thus not useful since complex software cannot be customized and produced with just the use of customer supplied specifications. In addition, just the production of software is not a "tangible result." Transformation of data

Art Unit: 2109

does not result in any "physical transformation." Still further, if the claims are rewritten as a manufacture, then they would have to include a proper computer readable medium, which is currently lacking.

**Claims 1-3** are a method for accomplishing the tasks specified in **claims 4-6**.

**Claims 1-3** are rejected for lacking a useful (credible) and tangible result, as discussed above.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claims 1-6**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Campbell et al (hereinafter Campbell) 6,377,951 issued Apr. 23, 2002 and filed Aug. 6, 1999 in view of Bowhill 2004/0015831 published Jan. 22, 2004 and filed Jan. 31, 2001.

In regards to **independent claim 4**, Campbell teaches (Campbell abstract):

- a software core module storage unit, which is used to store a pre-built software core module object;
- a functional module storage unit, which is used to store a set of pre-built functional module objects;
- a custom-made module storage unit, which is used to store a set of custom-made module objects;

- a database access management unit, which is used to control access operations on the software core module storage unit, the functional module storage unit, and the custom-made module storage unit;

Campbell fails to teach the use of custom option settings and specifications for producing custom-developed software packages.

However Bowhill (Bowhill Abstract) teaches a:

- modularized custom-developed software package producing system which is capable of automatically producing a custom-developed software package based on customer-designated specifications;
- custom-option setting unit, which is a user-input module for inputting a set of user-specified custom options that specify a set of functional module objects and custom-made module objects that are required for integration to the custom-developed software package;

With respect to **dependent claim 5**:

Campbell (Campbell Abstract) teaches the use of:

- functional module objects stored in the functional module storage unit include a group of pre-built core functional module objects and a group of custom-made functional module objects.

With respect to **dependent claim 6**:

Campbell (Campbell Abstract) teaches the use of:

- custom-made module objects stored in the custom-made module storage unit include a group of document file objects, a group of data file objects, and a group of custom-made interface objects.

Accordingly it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the systems of Campbell to incorporate the use of custom option settings and specifications of Bowhill, for producing custom-developed object-oriented software packages. Said system would teach every limitation of **claims 4-6**.

**Claims 1-3** are a method for accomplishing the tasks specified in **claims 4-6**. **Claims 1-3** are rejected because the claimed method is inherent in the software of **claims 4-6**.

Art Unit: 2109

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Document Number:	Name:
US-5,493,682	Tyra et al.
US-4,989,132	Mellender et al.
US-6,249,905	Yoshida et al.
US-52,109 A1	Nagashima et al.
US-6,557,165 B1	Nagashima et al.
US-5,864,862	Kriens et al.
US-5,437,027	Bannon et al.
US-5,297,279	Bannon et al.
US-5,937,405	Campbell, R. David L.
US-5,694,596	Campbell, R. David L.
US-5,758,160	McInerney et al.
WO 2001/31439	Method and Apparatus for Building a Self-Specializing Reusable Generic Component

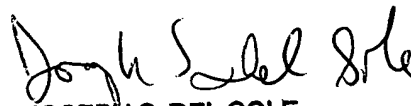


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evral Bodden whose telephone number is 571 272 3455. The examiner can normally be reached on Monday to Friday, 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on 5712721130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

\*\*\*

  
JOSEPH S. DEL SOLE  
PRIMARY EXAMINER  
1/25/07